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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,486	12/19/2000	Alan S. Waggoner	92053CONCIPCON	6161

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EXAMINER

PONNALURI, PADMAASHRI

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 09/05/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/740,486

Applicant(s)

WAGGONER, ALAN S.

Examiner

Padmashri Ponnaluri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-12, 15, 19 and 21-29 is/are pending in the application.
- 4a) Of the above claim(s) 9-12, 15, 19 and 21-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/28/03 has been entered.
2. The amendment D, filed on 7/28/03 has been fully considered and entered into the application.
3. New claims 25-29 have been added, and Claims 1-8, 13-14, 16-18, 20 have been canceled by the amendment D filed on 7/28/03. Claims 9-12, 15, 19, 21-24 have been withdrawn.
4. claims 9-12, 15, 19, 21-29 are currently pending and claims 25-29 are being examined in this application.
5. Claims 9-12, 15 and 19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 10.

Drawings

This application, filed under former 37 CFR 1.60, lacks formal drawings. The informal drawings filed in this application are acceptable for examination purposes. When the application

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is allowed, applicant will be required to submit new formal drawings. In unusual circumstances, the formal drawings from the abandoned parent application may be transferred by the grant of a petition under 37 CFR 1.182.

Information Disclosure Statement

The references by Ficken (1971), and Neblette, and JP 1-239548, JP 6-122696 in the information disclosure statement filed on 11/13/02 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because Ficken et al do recite the page numbers, Neblette does not provide the publication date, and no English translation of JP patents was provided. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

6. The information disclosure statement filed on 10/16/02 has not been considered because late filed Information disclosure (filed on 11/13/02) requested to ignore the IDs filed on 10/16/02.

7. The lengthy specification has not been checked to the extent necessary to determine the

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presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 25-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

The instant claims briefly recite 'a luminescent photostable reaction product of a component and water soluble dye selected from the group consisting of *sulfoindolenine- and naphthosulphoindolenine-based polymethine dyes*

The '*sulfoindolenine- and naphthosulphoindolenine-based polymethine dyes*' claimed in claims 25-29 has no clear support in the specification and claims as originally filed. The specification and the original claims are drawn to luminescent cyanine dyes or cyanine polymethine dyes. The specification discloses cyanine and related dyes. The specification discloses luminescent cyanine, merocyanine, stryryl, and oxanol dyes. The specification

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disclosure does not have support for '*sulfoindolenine- and naphthosulphoindolenine-based polymethine dyes*' having the recited properties. The instant claims read on a part of the cyanine dyes disclosed in the specification, i.e., sulfoindolenine- polymethine dye refers to only the dyes with polymethine and sulfoindolenine groups (no description of how the groups are linked), and which would not read on the cyanine dyes disclosed in the specification.

If applications disagree, applicant should present a detailed analysis as to why the claimed subject matter has clear support in the specification.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 U. S. P. Q. 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 U. S. P. Q. 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 U. S. P. Q. 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 U. S. P. Q. 644 (CCPA 1969).

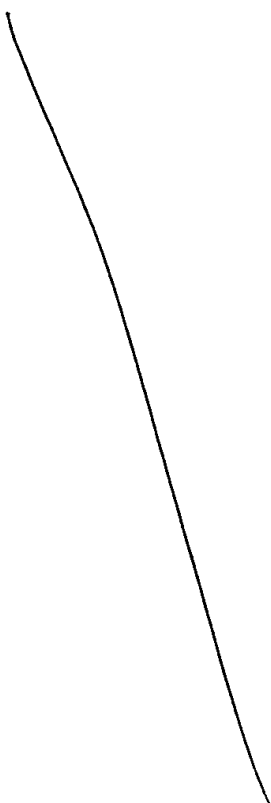
A timely filed terminal disclaimer in compliance with 37 CAR 1.321[©] may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CAR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CAR 3.73(b).

2. Claims 25-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,225,050.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the reference claims 1-3, 9-11 are drawn to a method of imparting luminescence to a component and claims 4-8 are drawn to a luminescence labeled component. The luminescence label of the reference is same as the instant claim luminescent label (cyanine dye). Thus it would have been obvious to use the same cyanine dye used in the reference method and in the component to label different component of the instant claims..



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3. Claims 25-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 5,627,027. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reference claims are drawn to a method of imparting luminescence to a component by adding cyanine dye of given structure to the component. The cyanine dye used in the reference method is same as the cyanine dye attached to the component of the instant claims. The reference in claim 10 recites that the product or component to be labeled with the cyanine dye is either proteins, cells, nucleic acids or DNA. Thus, it would have been obvious to use the cyanine dyes and the method of imparting luminescence to a component taught by the reference to get the luminescent labeled component of the instant claims.

4. Claims 25-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 5,569,766. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reference claims are drawn to a water soluble luminescent dye which dye is same as the cyanine dye used to label the components of the instant claims. It would have been obvious to use the luminescent dye of the reference to label a component (i.e., protein or nucleotide) to obtain a luminescent labeled component.

Conclusion

Note that Applicant's response filed on 7/28/03 has not addressed the obviousness type double patenting rejections made in the prior office actions mailed on 8/16/02 and 3/17/03.

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10. In view of Applicant's amendments and response filed on 7/28/03, the art rejections of record of canceled claims 17-18, 20 has been withdrawn.

5. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Padmashri Ponnaluri whose telephone number is 703-305-3884. The examiner is on *Increased Flex Schedule* and can normally be reached on Monday to Friday from 7.00 AM to 3.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 703-306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0916.


PADMASHRI PONNALURI
PRIMARY EXAMINER

Padmashri Ponnaluri
Primary Examiner
Art Unit 1639

pp
03 September 2003